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Satoru Ueda

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EXAMINER

YIGDALL, MICHAEL J

ART UNIT

PAPER NUMBER

2192

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/862,825

Applicant(s)

UEDA, SATORU

Examiner

Michael J. Yigdall

Art Unit

2192

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 8/1/06.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Office action is responsive to Applicant's submission filed on October 12, 2006.

Claims 1, 3, 4 and 10 are pending.

Response to Arguments

2. Applicant's arguments have been fully considered but they are not persuasive.

Applicant contends that Grundy does not disclose or suggest authorizing a user terminal to have an unlimited number of accesses to a purchased software program without at least one supplemental pay function when access to the at least one supplemental pay function is not requested, and that the cited sections of Reeder, Hellman and Oshima do not remedy the deficiencies of Grundy (remarks, page 8).

First, however, Grundy does disclose authorizing a user terminal to have an unlimited number of accesses to a software program (i.e., in evaluation mode) without at least one supplemental pay function when access to the at least one supplemental pay function (i.e., in full-function mode) is not requested (see, for example, column 4, lines 28-42 and 51-59, and column 12, lines 6-24). Applicant notes that the evaluation mode is for allowing potential users to try and evaluate features of the software program prior to deciding whether to purchase the software program (remarks, page 7), but this does not preclude applying Grundy's teachings to an already "purchased software program" as recited in the claims. For example, Grundy discloses that copies of the software program are distributed to potential users through standard channels (see, for example, column 8, line 59 to column 9, line 4), and suggests that copies may be distributed free of charge or at nominal costs (see, for example, column 1, lines 49-61).

Moreover, the rejection is based on a combination of Reeder, Hellman, Grundy and Oshima. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981), and *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant's argument that Reeder, Hellman and Oshima do not remedy the deficiencies of Grundy amounts to a general allegation of patentability and is therefore not persuasive. As set forth below, Reeder discloses a purchased software program (see, for example, page 3, lines 11-15) that includes at least one supplemental pay function (see, for example, page 10, lines 18-27), and in view of Grundy, Hellman and Oshima, teaches or suggests the claimed invention.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3, 4 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over International Pub. No. WO 97/14085 to Reeder (art of record, "Reeder") in view of U.S. Patent No. 4,658,093 to Hellman (art of record, "Hellman") in view of U.S. Patent No. 5,375,240 to Grundy (art of record, "Grundy") in view of U.S. Patent No. 6,081,785 to Oshima et al. (art of record, "Oshima").

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With respect to claim 1 (currently amended), Reeder discloses a software program providing system for providing and managing access to a software program (see, for example, FIG. 1 and page 3, lines 11-15), said system comprising:

(a) a storage medium for storing a purchased software program and for storing an individual identification code that identifies said storage medium (see, for example, store 150 in FIG. 1, and page 5, lines 1-7, which shows a store or storage medium for storing a software program and an identification code used to identify the program in the storage medium, and see, for example, page 7, lines 30-37, which shows that the software program is purchased), the purchased software program including at least one supplemental pay function (see, for example, page 10, lines 18-27, which shows a plurality of supplemental pay features or functions);

(b) a user terminal for installing said storage medium therein and for accessing the purchased software program stored in said storage medium (see, for example, apparatus 100 in FIG. 1, and page 3, lines 11-15 and line 32 to page 4, line 6, which shows a personal computer or user terminal having a storage medium installed therein for storing and accessing software programs, and see, for example, page 5, lines 10-14, which shows obtaining the software program and storing it in the storage medium);

(c) database management means for storing a database which includes individual information of a user, information regarding a range of access limitations to the purchased software program, and information regarding a condition of access to the software program, and which is searchable using the individual identification code as a search key (see, for example, code data 230 and bill log 240 in FIG. 1, and page 6, line 37 to page 7, line 5, which shows a data store or database having individual user information regarding software usage rights, i.e.

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access limitations and conditions of access, which is searched based on an identification code), the information regarding the range of access limitations including information identifying the at least one supplemental pay function (see, for example, page 10, lines 18-27, which shows information identifying the supplemental pay features or functions), the information regarding the condition of access including an associated number of used counts for the at least one supplemental pay function, the associated number of used counts indicating the number of prior accesses by the user to the at least one supplemental pay function (see, for example, page 11, line 31 to page 12, line 14, which shows an associated record or count of each use of the feature or function).

Reeder discloses an associated message number (see, for example, page 11, lines 8-19) that is incremented when a feature or function is purchased (see, for example, column 10, lines 31-34), but does not expressly disclose the information regarding the condition of access including an associated number of purchased counts for the at least one supplemental pay function, the associated number of purchased counts indicating the number of prepaid accesses by the user to the at least one supplemental pay function.

However, Hellman discloses a system for distributing and managing access to a software program (see, for example, the abstract), including an associated number of purchased counts that indicates the number of prepaid accesses to the software program (see, for example, column 10, lines 8-13). The system enables the use of the software program to be authorized for a particular user terminal a specific number of times (see, for example, column 4, lines 37-45).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Reeder to include an associated number of purchased counts

indicating the number of prepaid accesses to a given one of the plurality of supplemental pay functions, so as to authorize the use of the supplemental pay function for a specific number of times, as taught by Hellman.

Reeder also discloses said database management means including fee charging means for charging a fee to add to the associated number of purchased counts for the at least one supplemental pay function (see, for example, page 9, lines 25-27, which shows fee charging means for charging a fee to access the supplemental pay functions, and page 13, lines 7-15, which shows that access to the functions may be prepaid).

Hellman likewise further discloses charging a fee to add to the associated number of purchased counts (see, for example, column 5, lines 51-56).

Reeder also discloses:

(d) information communication means for connecting said database management means with said user terminal (see, for example, communications link 10 and network 20 in FIG. 1, and page 3, lines 21-31), said database management means reading the individual identification code from said storage medium installed in said user terminal through said information communication means (see, for example, page 10, lines 6-17, which shows reading a identification code from a storage medium, and page 11, lines 15-29, which then shows authorizing the use of a software program based on access limitations and conditions);

said software providing system authorizing said user terminal to have at least one access to the purchased software program including the at least one supplemental pay function based on the information regarding the range of access limitations (see, for example, page 7, lines 30-37, and page 9, lines 25-27).

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Hellman further discloses authorizing the user terminal to access the software program based on whether the associated number of purchased counts exceeds the associated number of used counts when access to the at least one supplemental pay function is requested (see, for example, column 10, lines 33-54, which shows authorizing access to the software program if the associated number of purchased counts is greater than 0, i.e. if the associated number of purchased counts exceeds the number of times the software program was used).

Reeder does not expressly disclose said software program providing system authorizing said user terminal to have an unlimited number of accesses to the purchased software program without the at least one supplemental pay function when access to the at least one supplemental pay function is not requested.

However, Grundy discloses a system for distributing and managing access to a software program that includes authorizing unlimited access to the software program in evaluation mode without any supplemental pay functions when full-function mode is not requested, so that the user may freely try and evaluate the software program without paying any additional fees (see, for example, column 4, lines 28-42 and 51-59).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Reeder such that the software providing system authorizes said user terminal to have an unlimited number of accesses to the purchased software program without the at least one supplemental pay function when access to the at least one supplemental pay function is not requested, as taught by Grundy, so as to allow the user to try and evaluate and the purchased software program without paying additional fees for supplemental pay functions that are not requested.

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Reeder also discloses said database management means incrementing the associated number of used counts after the at least one access to the purchased software program including at least one supplemental pay function is concluded (see, for example, page 11, line 31 to page 12, line 14, which shows incrementing the associated record or count for each use of the feature or function).

Grundy further discloses:

said user terminal including a display having a graphical-user-interface for enabling the user to select between the unlimited number of accesses to the purchased software program without the at least one supplemental pay function and the paid access to the purchased software program including the at least one supplemental pay function (see, for example, column 12, lines 6-24, which shows a graphical user interface on which the software program displays a banner page to enable the user to select between unlimited access to the software program in evaluation mode and paid access to the software program in full-function mode).

Reeder does not expressly disclose that said storage medium is a removable storage medium.

However, Oshima discloses a system for providing and managing access to a software program stored with an identification code on a removable, optical storage medium, wherein the software is installed on a user terminal from the removable storage medium, for the purpose of preventing illegal copying of the software (see, for example, column 10, lines 15-54, and see, for example, FIG. 11, which shows a personal computer or user terminal and an optical disk drive).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Reeder to provide the software program on a removable

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storage medium to be installed in the user terminal, as taught by Oshima. The modification would have been obvious because one of ordinary skill in the art would have been motivated to enhance the level of protection against illegal copying or installation of the software.

With respect to claim 3 (previously presented), the rejection of claim 1 is incorporated, and Reeder also discloses the limitation wherein said information communication means further comprises ciphering means for ciphering communication between said database and said user terminal (see, for example, page 7, lines 5-9, which shows an encryption or ciphering process).

With respect to claim 4 (previously presented), the rejection of claim 1 is incorporated. Reeder discloses the use of encryption to provide additional security (see, for example, page 5, line 33 to page 6, line 1), but does not expressly disclose that said storage means further comprises a DVD-ROM, and the individual identification code includes a BCA code recorded using a laser beam during a fabrication process of the individual identification code.

However, Oshima further discloses the use of the BCA to store an identification code and a cryptographic key (see, for example, column 1, lines 36-50) on a DVD (see, for example, column 3, lines 63-67), so that a fee may be charged for the use of the disk (see, for example, column 4, lines 60-64). Oshima further discloses that the BCA code is recorded with a laser during fabrication and can be used for security (see, for example, column 3, lines 11-15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Reeder to use a DVD-ROM storage medium with a BCA identification code, as taught by Oshima. The modification would have been obvious because

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one of ordinary skill in the art would have been motivated to improve security by transcribing the storage medium with an individual identification code.

With respect to claim 10 (currently amended), the claim recites a software program providing system that corresponds to the software program providing system of claim 1 (see the rejection of claim 1 above).

Conclusion

5. Applicant's amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Yigdall whose telephone number is (571) 272-3707. The examiner can normally be reached on Monday through Friday from 7:30am to 4:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MY

Michael J. Yigdall
Examiner
Art Unit 2192

mjy



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SUPERVISORY PATENT EXAMINER